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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUSANTA DATTA

Appeal 2008-1142
Application 10/719,768
Technology Center 2800

Decided: July 15, 2008

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
KEVIN F. TURNER, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL

Appeal 2008-1142
Application 10/719,768

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 10-12. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

INVENTION

Appellant's claimed invention is directed to a method of washing an unsealed electric motor assembly used in food or medicine preparation applications, wherein the unsealed housing of the motor is made out of non-corroding material (Spec. 2: ¶[00011]). The unsealed housing is further configured to permit the washing fluid to be driven off by thermal energy generated by operation of the electric motor (Spec. 3: ¶[00012]).

Claim 10, reproduced below, is representative of the subject matter on appeal:

10. A method of washing an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components, comprising the steps of:

washing the unsealed electric motor assembly with a washing fluid, whereby the washing fluid is permitted to enter the interior of the unsealed electric motor assembly;

removing the washing fluid from the unsealed electric motor assembly; and

operating the electric motor, whereby residual washing fluid remaining within the unsealed electric motor assembly is driven off as a result of the heating of the motor during said operation;

whereby said electric motor and said electric motor assembly are cleaned, and said electric motor is protected against failure from corrosion by the driving off of the residual fluid from the unsealed electric motor assembly.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Perl	US 3,750,951	Aug. 07, 1973
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A. W. Selders, *Electric Motors - Lubrication and Cleaning*, Agricultural Engineering, Cooperative Extension Service West Virginia University (Oct. 25, 1968).

The following rejections are before us for review:

1. Claims 10 and 11 stand rejected under 35 U.S.C. § 102(b) as being unpatentable over Perl.
2. Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Perl in view of Selders.

ANTICIPATION

There are multiple anticipation issues before us regarding whether Appellant has shown that the Examiner erred in rejecting claims 10 and 11 under 35 U.S.C. § 102(b).

We present these issues as they correspond to, and in the order of,
Appellant's presented arguments:

Regarding claims 10 and 11

a) Did the Examiner err in determining that Perl teaches a non-corroding housing material such as stainless steel?

b) Did the Examiner err in determining that Perl teaches that the electric motor and the electric motor assembly are cleaned?

c) Did the Examiner err in determining that Perl teaches that residual washing fluid remaining within the unsealed electric motor assembly is driven off as a result of the heating of the motor as claimed?

d) Did the Examiner err in determining that the preamble is only a statement of intended use?

FINDINGS OF FACT

The relevant facts include the following:

1. Perl teaches that jacket 64 is preferably formed of non-magnetic stainless steel (col. 5, ll. 15-16).
2. Perl teaches that the jacket 64 encloses stator 65 (col. 4, ll. 66-67).
3. Appellant's disclosure recognizes stainless steel as non-corroding material (Spec. 3: ¶ [0006]).
4. Perl teaches directing water into intimate contact with a drive motor, both internally and externally (col. 1, l. 66-col. 2, l. 2).
5. Perl further teaches utilization of the heat from the motor for cleaning, sanitizing, and drying purposes (col. 1, ll. 3-8).

6. Appellant's disclosure does not provide a special definition of what constitutes "clean."
7. Perl is not merely concerned with providing cosmetically acceptable results, but also sanitization (col. 1, ll. 3-8).
8. Appellant's disclosure states that mixing of food preparations or medicine manufacture necessitates cleaning and/or disinfecting surfaces of the motor assembly (Spec. ¶ [0006]).
9. Appellant's disclosure states that "[t]he washing fluid can be drained from the motor assembly, for example by gravity, as part of the washing fluid removal process. Residual moisture that would otherwise remain within the motor assembly is removed (or driven off) by the heat generated by operating the motor" (Spec. ¶ [0071]).
10. Perl teaches that "when the dishwasher is evacuated of water a heating effect occurs upon the air therein if the motor 66 is energized, which may assist in the drying cycle of operation" (col. 5, ll. 38-41).
11. Perl teaches that the heat energy generated from the motor elevates the water temperature for drying purposes (col. 1, ll. 3-8).
12. Appellant's disclosure describes that the motor assembly can be "reassembled" in the apparatus after cleaning (Spec. ¶ [00071]).

PRINCIPLES OF LAW

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. Inc., v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Claim terms are presumed to have their customary and ordinary meaning unless there is an express intention to impart the novel meaning of the claim terms. *Sunrace Roots Enterprise Co., Ltd. v. SRAM Corp.*, 336 F.3d 1298, 1302 (Fed. Cir. 2003).

Language in a claim preamble acts as a claim limitation only when it gives meaning to a claim and properly defines the invention and not merely when it states a purpose or intended use of the invention. *In re Paulsen*, 30 F.3d 1475, 1479 (Fed. Cir. 1994).

ANALYSIS

Initially, we note that Appellant’s arguments have grouped claims 10 and 11 together. Thus in accordance with 37 CFR §41.37(c)(1)(vii) we select independent claim 10 as representative of the group of claims.

Regarding claims 10 and 11

a) Did the Examiner err in determining that Perl teaches a non-corroding housing material such as stainless steel?

Appellant argues that: “[n]othing in the disclosure of the Perl patent teaches or suggests any property of any element of the described motor with regard to prevention of corrosion or protecting against failure from corrosion” (Br. 11). The Appellant further states that while “[t]he jacket 64 is preferably formed of non-

magnetic stainless steel” (emphasis in original) (Br. 10, citing Perl col. 5, ll. 15-17), it is “clear to one of ordinary skill that a non-magnetic jacket is needed if used between the stator and rotor of an electric motor, and stainless steel happens to be a convenient non-magnetic material for such use” (emphasis in original) (Br. 10-11).

The Examiner responds that Perl teaches the motor including “a non-magnetic, stainless steel housing 64, which is inherently non-corrosive” (Ans. 5). The Examiner further states that “Appellant’s argument that Perl’s stainless steel housing is not inherently non-corrosive is not persuasive because Appellant admits that stainless steel is non-corrosive (see paragraph 0006, lines [sic] 8)” (Ans. 5).

We agree with the Examiner’s findings of fact and conclusions and adopt them as our own. We add the following primarily for emphasis.

Perl teaches that jacket 64 is preferably formed of non-magnetic stainless steel (Finding of Fact 1). Furthermore, Perl teaches that the jacket 64 encloses stator 65 (Finding of Fact 2). It follows that jacket 64 constitutes a motor housing made out of stainless steel (Findings of Fact 1 and 2). Appellant’s disclosure describes stainless steel as non-corroding material (Finding of Fact 3). Thus, it follows that Perl teaches a motor housing made out of non-corroding material. Even, if it is true that Perl used stainless steel solely due to its non-magnetic properties, nonetheless, stainless steel is inherently non-corrosive as per Appellant’s own admission (Finding of Fact 3).

Thus, Appellant’s argument has not persuaded us of error in the Examiner’s rejection since Perl teaches a motor housing made of non-corroding material (Findings of Fact 1-3).

b) Did the Examiner err in determining that Perl teaches that the electric motor and the electric motor assembly are cleaned?

Appellant argues that “[i]t is the expectation of the undersigned, based on personal experience, that after many dishwashing cycles performed according to the Perl invention, the motor of Perl will be significantly more dirty than when it was first put into use” (Br. 11). The Appellant disagrees with the Examiner’s position that the motor inherently gets cleaned every time it is used (Br. 11). The Appellant states that “[t]he Examiner does not account for the possibility that the motor in fact may retain within its housing material removed from the dirty dishes, and that regions of the interior of the motor or its housing or sump may become permanently fouled with residue or particulate matter that is introduced with the dirty dishes” (Br. 11-12). Furthermore, the Appellant states that “[i]n using the Perl invention, the internal condition of the motor as regards cleanliness [sic] is irrelevant as long as the dishwasher provides cosmetically acceptable results” (Br. 12).

The Examiner responds that “the motor is washed while washing the dishes because the washing water is flowing through the motor” (Ans. 5). Furthermore, the Examiner states that “Appellant may have a different definition of ‘washed’ or ‘cleaned,’ but the claim does not reflect . . . the degree of cleanliness” (Ans. 6).

We agree with the Examiner’s findings of fact and conclusions and adopt them as our own. We add the following primarily for emphasis.
Perl teaches directing water into intimate contact with a drive motor, both internally and externally (Finding of Fact 4). Perl further teaches utilization of the

heat from the motor for cleaning, sanitizing, and drying purposes (Finding of Fact 5). Appellant's disclosure does not provide a special definition of what constitutes "clean" (Finding of Fact 6). Thus, it follows that Perl's intimate washing of the motor during washing cycles would satisfy the limitation of "whereby said electric motor and said electric motor assembly are cleaned" as recited in claim 10.

Furthermore, it is clear that Perl is not merely concerned with providing cosmetically acceptable results, but also sanitization (Finding of Fact 7). Finally, it is unclear how the mixing of food preparations which necessitates cleaning and/or disinfecting surfaces of the motor assembly as stated in Appellant's disclosure (Finding of Fact 8) would be creating any less residue or particulate matter formation on the motor surfaces than that of Perl's dishwasher motor.

Thus, Appellant's argument has not persuaded us of error in the Examiner's rejection because Perl by directing the water into intimate contact with a drive motor would necessarily clean the motor (Finding of Fact 4).

For the above reasons, Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by Perl.

c) Did the Examiner err in determining that Perl teaches that residual washing fluid remaining within the unsealed electric motor assembly is driven off as a result of the heating of the motor as claimed?

Appellant argues that Perl "does not teach or suggest driving the water off from the motor by heating, because . . . the water is already evacuated" (Br. 12). Furthermore, Appellant argues that Perl is interested in drying the dishes and any

incidental drying of the motor would result in diminution of the drying effect on the dishes (Br. 12). Appellant states that “Perl is disinterested in the question whether [sic] the motor may or may not be dried” (Br. 13).

The Examiner responds that “Perl teaches the exact same steps as the Appellant’s claims, those being permitting washing fluid to enter an unsealed motor, removing the washing fluid (col. 5, line 39: evacuating the water), and operating the motor (col. 5, line 40: energizing with motor) to remove residual water” (Ans. 6). The Examiner further states that the “heat from the motor which is drying the dishes in a separate compartment of the dishwasher, is [sic] must also dry any residual washing fluid with is [sic] in direct contact with the motor parts” (Ans. 6-7). The Examiner further states that Appellant’s own disclosure states that residual moisture would be driven off by the heat generated by operating the motor and hence, Appellant cannot rationally argue that Perl’s heat generated by the motor would not also inherently drive off the residual fluid (Ans. 7 and Spec. ¶ [00071]).

We agree with the Examiner’s findings of fact and conclusions and adopt them as our own. We add the following primarily for emphasis.

Appellant’s disclosure states that “[t]he washing fluid can be drained from the motor assembly, for example by gravity, as part of the washing fluid removal process. Residual moisture that would otherwise remain within the motor assembly is removed (or driven off) by the heat generated by operating the motor” (Finding of Fact 9). Similarly, Perl teaches that “when the dishwater is evacuated of water a heating effect occurs upon the air therein if the motor 66 is energized which may assist in the drying cycle of operation” (Finding of Fact 10).

Furthermore, Perl teaches that the heat energy generated from the motor elevates the water temperature for drying purposes (Finding of Fact 11). Thus, it follows that Perl discloses that the dishes are dried by both the heated water and the heat generated from the motor operation after the water is drained (Findings of Fact 10 and 11). Thus, if the heat of the motor assists in drying the dishes, then it follows that the motor and motor parts in direct contact with the generated heat would also be dried.

Thus, Appellant's argument has not persuaded us of error in the Examiner's rejection because any residual washing fluid remaining within the unsealed electric motor assembly would be driven off as a result of the heating of the motor as claimed.

For the above reasons, Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by Perl.

d) Did the Examiner err in determining that the preamble is only a statement of intended use?

Appellant argues that the preamble “an unsealed electric motor assembly used in food or medicine preparation activities subject to FDA oversight, wherein the motor assembly includes an unsealed non-corroding housing material and a motor having non-corroding components’ gives ‘life, meaning and vitality to the claim’ . . . and is not merely a statement of intended use” (Br. 16). Furthermore, Appellant states that Perl does not teach or suggest use of the motor in food or medicine preparation activities subject to FDA oversight (Br. 17).

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Appellant further explains that Perl's utensils are clean but not sterile (Br. 17). Appellant further states that sterilization requires use of autoclave, operating at high temperatures rather than a dishwasher (Br. 17).

The Examiner considers the preamble as a statement of intended use because the claimed process steps do not refer back to the FDA oversight and nor does the structure rely on food or drug preparation or FDA oversight (Ans. 8).

As stated *supra*, language in a claim preamble acts as a claim limitation only when it gives meaning to a claim and properly defines the invention and not merely when it states a purpose or intended use of the invention. *In re Paulsen*, 30 F.3d at 1479 (Fed. Cir. 1994).

Thus, we are not persuaded by Appellant's argument because the preamble language of "food or medicine preparation activities subject to FDA oversight" does not give meaning to the recited method steps and it merely constitutes the intended use of the invention. Furthermore, contrary to Appellant's argument, Perl is concerned with sterilization of the utensils and not merely cleaning the utensils (Finding of Fact 5).¹

For the above reasons, Appellant's arguments have not persuaded us of error in the Examiner's rejection of claims 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by Perl.

¹ The Examiner noted that if the preamble constituted a claim limitation then the claim limitation would be indefinite since FDA oversight changes at the whim of Congress and the Food and Drug Administration (Ans. 9). We interpret Perl's sanitization (col. 1, ll. 3-8) as satisfying the claim language.

In summary, we hereby sustain the Examiner's anticipation rejection of claims 10 and 11.

OBVIOUSNESS

There is a single obviousness issue before us regarding whether Appellant has shown that the Examiner erred in rejecting claim 12 under 35 U.S.C. § 103(a).

Regarding claim 12

Did the Examiner err in determining that Perl in view of Selders teach or suggest removal of the motor from an apparatus as claimed?

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

The Examiner's “articulated reasoning . . . in the rejection must possess a

rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). The Supreme Court, citing *In re Kahn*, 441 F.3d at 988, stated that “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. at 1741. However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

Although claims are interpreted in light of the specification, limitations from the specification are not read into the claims. *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993).

Regarding claim 12

Did the Examiner err in determining that Perl in view of Selders teach or suggest removal of the motor from an apparatus as claimed?

Appellant argues that “[r]emoval of a motor from an apparatus to which it is mounted is not the same as disassembly of a motor for cleaning” (Br. 19). Thus, Appellant argues that Selder’s disassembly of the motor for cleaning is not the same as removal of the motor as claimed by Appellant (Br. 19-21). Appellant further explains:

[w]hile Selders does describe removing at least one end shield and the rotor associated therewith from the remainder of the motor (Selders at page 2, paragraph #3), there is no teaching or suggestion that such

removal requires that the motor itself be removed or detached from the apparatus with which it cooperates.

(Br. 21).

The Examiner responds that Selders' 12 cleaning steps cannot be performed when the motor is attached to the driven apparatus and in particular the endshield and the rotor cannot be removed if the motor is still attached to the driven device (step 3) (Ans. 9). The Examiner further explains that the rotor of Perl cannot be removed unless the stator with the resin housing 44 or the stator with the stainless steel housing 64 is removed from the dishwasher (Ans. 10). We agree with the Examiner's findings of fact and conclusion and we adopt them as our own. Furthermore, we note that Appellant's disclosure describes that the motor assembly can be "reassembled" in the apparatus after cleaning (Finding of Fact 12). Thus, while Appellant argues that "disassemble" is not the same as "removal," the disclosure nonetheless uses the term of "reassembled" to mean inserting the motor in the apparatus. Therefore, Appellant's own disclosure appears to support the Examiner's construction of the term "disassemble" to mean "removal" (Finding of Fact 12).

Appellant further argues that there is no motivation to combine the teachings of Perl and Selders (Br. 24).

The Examiner's articulated reasoning in the rejection, that Selders teaches a thorough cleaning and routine maintenance on the bearings which can only be achieved by disassembling the motor and removing the motor from the driven device (page 2, paragraph 3) (Ans. 10), possesses a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d at 988.

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Furthermore, we are not persuaded by Appellant's argument regarding the time between cleaning and the types of bearings (Br. 22-23), because such limitations are not claimed.

For the above reasons, Appellant's arguments have not persuaded us of error in the Examiner's rejection of claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Perl in view of Selders, and we sustain the Examiner's rejection.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 10 and 11 under 35 U.S.C. § 102(b). We also conclude that the Appellant has not shown that the Examiner erred in rejecting claim 12 under 35 U.S.C. § 103(a).

DECISION

The decision of the Examiner to reject claims 10, 11, and 12 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

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AFFIRMED

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